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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Simon Robert Walmsley

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393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

TRAORE, FATOUMATA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,274	Applicant(s) WALMSLEY, SIMON ROBERT	
	Examiner FATOUMATA TRAORE	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendment filed November 5, 2008. Claims 1 and 2 have been amended. Claims 10-15 has been cancelled. Claims 1-9 are pending and have been considered below.

Response to Arguments

2. Applicant argues that the newly added limitation are not discloses in the prior art of record. However, after further review and consideration, it is submitted that Hohberger et al (US 2003/0059050) discloses the newly added limitation (see paragraphs [0037], [0039], [0040] and [0041]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collins (US 7,095,855) in view of Hohberger et al (US 2003/0059050).

Claim 1: Collins discloses a message a method of generating and sending a message from a first entity to a second entity, the first entity being an authentication integrated circuit of a printer consumable and the second entity

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being an authentication integrated circuit of a printer, the method including the steps of:

- i. Determining a message including an action (*column 1, line 49-55, column 6, lines 4-36*);
- ii. Generating an authentication code on the basis of the action (*application*) and a parameter (*application identifier*) by applying a one-way function to the action and parameter, the parameter being indicative of an attribute of the action the (*The message unique value 502 is combined with the secret value 400 in combination process 504 to form a secret message unique value 506. The secret message unique value 506 is unique to the particular message, device and application. The combination process 504 can be implemented using the symmetric encryption based one way functions used in the financial industry, and/or hash functions such as SHA-1 and MD5*) (*column 1, lines 55-62; column 2, lines 34-42; column 3 lines 15-22; column 5, line 57 to column 6 line 4; column 10, lines 44-57: Fig. 6b, item 1002*); and
- iii. Sending the message and authentication code from the first entity to the second entity(*to form a secure message for transmission*) (*column 1 lines 63-67*).

Collins does not explicitly disclose that the first entity is being an authentication integrated circuit of a printer consumable and the second entity being an authentication integrated circuit of a printer. However Hohberger et al discloses

a method for article authentication, which further discloses that the first entity being an authentication integrated circuit of a printer consumable(*consumable article 120*) and the second entity being an authentication integrated circuit of a printer(*host device 100*)(*paragraphs [0038]0041*)). Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify the teaching of Collins such as identify the first entity and the second entity as being an integrated circuit of a printer consumable and an integrated circuit of a printer. The motivation of doing so would have been to provide an anti-piracy deterrent as taught by Hohberger et al (paragraph [0003])

Claim 2: Collins discloses a message a method of generating and sending a message from a first entity to a second entity, the first entity being an authentication integrated circuit of a printer consumable and including an identifier that distinguishes it from a plurality of other entities of other printer consumables, the second entity being an authentication integrated circuit of a printer, the method including the steps of:

- i. Determining a message including an action (column 1, line 49-55, column 6, lines 4-36);
- ii. Generating an authentication code on the basis of the action (*application*) and a parameter (*application identifier*) by applying a one-way function to the action and parameter, the parameter being indicative of an attribute of the action the (*The message unique value 502 is combined with the secret value 400 in combination process 504 to form a*

secret message unique value 506. The secret message unique value 506 is unique to the particular message, device and application. The combination process 504 can be implemented using the symmetric encryption based one way functions used in the financial industry, and/or hash functions such as SHA-1 and MD5) (column 1, lines 55-62; column 2, lines 34-42; column 3 lines 15-22; column 5, line 57 to column 6 line 4; column 10, lines 44-57: Fig. 6b, item 1002); and

iii. Sending the message and authentication code from the first entity to the second entity(*to form a secure message for transmission*) (column 1 lines 63-67).

Collins does not explicitly disclose that the first entity is an authentication integrated circuit of a printer consumable and including an identifier that distinguishes it from a plurality of other entities of other printer consumables, the second entity being an authentication integrated circuit of a printer. However Hohberger et al discloses a method for article authentication, which further discloses that the first entity being an authentication integrated circuit of a printer consumable (*consumable article 120*) and including an identifier(*unique factory serial number*) that distinguishes it from a plurality of other entities of other printer consumables, the second entity being an authentication integrated circuit of a printer (*host device 100*)(*paragraphs [0037], [0038], [0040], [0041]*). Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify the teaching of Collins such as identify the first

entity and the second entity as being an integrated circuit of a printer consumable and an integrated circuit of a printer. The motivation of doing so would have been to provide

Claims 3/1, 3/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 1 and 2 above, and Collins further discloses that the action (*application*) is a function, and the parameter (*application identifier*) is indicative of the function (*each communication type is associated with a particular application in the issuer device and a corresponding application in the holder device*) (column 5 line 57 to column 6 line 4).

Claims 4/1, 4/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 3/1 and 3/2 above, and Collins further discloses that the entity is capable of generating messages for each of a plurality of types of function, and the parameter is indicative of the type of function comprised by the message that is sent (*the corresponding applications 206 and 208 are assigned application identity values 406 and 414, to permit identification of an application or purpose for a particular message*) (column 7 line 19 to column 8 line 4; Fig 2; Table 1).

Claims 5/1, 5/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 3/1 and 3/2 above, and Collins further discloses that the message includes one or more operands of the function (column 7 line 19 to column 8 line 4; Fig 2; Table 1).

Claims 6/1, 6/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 5/1 and 5/2 above, and Collins further discloses that the function is a read function and the one or more operands include an address to be read (*From a practical perspective, secure communications between the user 1034 and the banking service 1032, are used for transactions ranging from initial log on and password hand shaking between the banking service 1032 and the user 1034, through to other banking transactions such as reading an account balance, transferring funds and so on*)(column 12, lines 20-45).

Claims 7/1, 7/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 5/1 and 5/2 above, and Collins further discloses that the function is a write function and the one or more operands include data to be written (*column 7, lines 37-45*).

Claims 8/1, 8/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 4/1 and 4/2 above, and Collins further discloses that the types of function include at least a read and a write, wherein the authentication step produces a different authentication code depending upon whether the action is a read or a write (*column 7 line 19 to column 8 line 4*).

Claims 9/1, 9/2: Collins and Hohberger et al disclose a message a method of generating and sending a message from a first entity as in claims 4/1 and 4/2 above, and Collins further discloses that the authentication step produces

includes authentication codes (this process can be selected appropriately to provide symmetric key encryption for confidentiality, or for providing a message integrity mechanism, such as message authentication code or keyed hash function or simply as a secret one time value within a higher level protocol) (column 9, lines 30-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fatoumata Traore whose telephone number is (571) 270-1685. The examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:00 p.m. and every other Friday from 7:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nassar G. Moazzami, can be reached on (571) 272 4195. The fax phone number for Formal or Official faxes to Technology Center 2100 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 270-2685.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-2100.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Friday January 23, 2009

/F. T./

Examiner, Art Unit 2436

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2436